

## REMARKS

Claims 1 – 58, 60 – 63 and 66 – 140 are pending. To facilitate examination of the case, Applicant has reproduced the text of all the pending independent claims, along with an indication of whether they were amended again in this response, or if only in a prior response.

As an initial matter, Applicant notes that there are a number of obvious errors both in the §112 rejections and § 103 rejections which make the Office Action ambiguous and difficult to respond to in a meaningful fashion. The examiner is required under 37 C.F.R. 113 to repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof. The goal is to ensure that a clear issue can be developed between applicant and examiner before appeal.

However, the Second Office Action is non-responsive on many of the § 112 issues, and does not contain any rebuttal of arguments raised in the Applicants' reply. At this point it is impossible to understand what the Examiner is contending for many of the points raised. Furthermore, for many of the rejection of the claims under § 103 the Examiner apparently did not consider the actual language of the claims, and/or their dependency and relationship to other claims. For example, the Examiner has made almost 20 separate errors by rejecting *dependent* claims based on references that he did not apply to the *independent* claim from which such claims depend. *See e.g.*, the rejections of claims 17, 18, 19, 21, 23, 27, 28, 37, 38, 62, 63, 66, 68, 69, 71, 127, 130, 137 and 140. This is plainly in error, and there is no meaningful way for Applicants to decide what the resulting rejections really are for such claims, let alone to respond to such rejections.

In addition, no actual rejection was issued for claims 35, 85 and 133, and so their status is also uncertain.<sup>1</sup>

On this basis, Applicant requests that until the Office Action is clarified and presented in a manner that makes it possible to respond, the finality of the prior Office Action should be withdrawn.<sup>2</sup>

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<sup>1</sup> Despite this omission, Applicants have endeavored to glean what the Examiner's intent was, and to respond on a best efforts basis for such claims.

<sup>2</sup> Applicants are also not clear if the Office Action was intended to be final or not, since the front summary sheet has both boxes checked off (final and non-final), while the first paragraph of the first page says the action is final. Nonetheless, if the Office Action was intended to be final, it does not recite the standard paragraph language from MPEP 706.07 (paragraph 7.39) repeating such determination at the end of the response, and providing the Applicant with an opportunity to file a first reply within 2 months. Accordingly, out of an abundance of caution Applicants have treated the Office Action as final, but they are uncertain as to the true intention of the Examiner, and would appreciate having this clarified in writing.

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In addition, the Examiner has not applied a correct standard in concluding that the claims are obvious, as is apparent from numerous sections of the Office Action. As a typical example see the following passage from the Office Action concerning pending claim 2:

“...Bradshaw et al fail to explicitly disclose ‘The method ....designating words that have a meaning that is potentially inappropriate by changing a value of a status field....’ However Cragun et al –1 disclose “...browsing software having the ability to recognize rating labels...” (citations omitted) and Cragun et al –2 disclose “...the adult user can control the value associated with every individual category.... (citations omitted) It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Bradshaw et al, Cragun et al-1, Cragun et al-2, because Cragun et al-2 teach above, allowing an adult user to control the values of offensiveness of the contents being accessed by a user. (Page 11 of the Office Action).

This contention is plainly insufficient to meet any standard of obviousness used by the PTO. This is because the Examiner acknowledges the deficiencies of Bradshaw, but then concludes *that the mere existence of a feature in Cragun et al – 2* (user control) is in itself a suggestion to incorporate it into the former reference. There is in fact no evidence of a separate teaching, suggestion or motivation proven by the Examiner to include this feature in Bradshaw, however, and without the same an obviousness rejection is not sustainable.

The burden is on the PTO to produce sufficient evidence of prima facie obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ 2d 1955, 1956 (Fed. Cir. 1993); In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). It is apparent that a complete lack of evidence cannot meet the criteria needed for a prima facie case of obviousness, and, as in the present case, the rejections should be overturned. *See e.g.*, Rijckaert 9 F. 3d at 1532; In re Neilson, 816 F.2d 1567, 1572, 2 USPQ 2d 1525, 1528 (Fed. Cir. 1984); In Re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Unfortunately this logic is duplicated several times throughout the Office Action, and accordingly, Applicants submit that the obviousness rejections accompanying this logic are in fact not sustainable.

It is apparent that ascribing “final” status to this case was an overly hasty decision, as Applicant has not received a fair explanation of the real rationale or a real basis for the present rejections. Despite this difficulty Applicants have nonetheless labored to address the rejections in as best a fashion they can, and have amended the claims so as to remove any possible remaining substantive obstacle to their allowance. For this reason, Applicants believe that the case should be seriously considered for allowance regardless of its present status as final or non-final.

## RESPONSE TO § 112 REJECTIONS

Applicant submits that there are a number of obvious errors with the Examiner's 112 rejections repeated in the most recent Office Action. In particular, it does not seem that the Examiner even considered several of the amendments made to the claims, or the other supporting passages noted by the Applicants. These obvious errors should be addressed at the earliest opportunity to clarify the issues in the present case.

For instance, to address paragraph 7 of the Office Action: claim 7 does not even recite the "status flag" limitation noted by the Examiner, and yet it is still rejected by the Examiner on that basis. Claim 65 has been canceled, but again the Examiner has issued a rejection against it. To resolve any further ambiguities in this regard, claims 21 and 46 have been amended as well.

In paragraph 8 the continuing rejection by the Examiner under § 112 is also not understood or well articulated, since it was addressed in detail by the Applicants in pages 33 - 34 of the Amendment filed June 9, 2000, and the claims were further clarified to remove any possible ambiguities. The Examiner, in fact, did not raise even a single specific argument to rebut this substantial evidence provided by the Applicants on this point. As such, the rejection does not seem sustainable, and Applicants are at a loss to understand the basis therefor. The only explanation that Applicants can gather for the continuing rejection is that the Examiner is apparently misinterpreting the language of the claim, but as there is no particularized explanation of what the Examiner is contending on this point, the Applicants are not being given a fair or adequate opportunity to address the substance of such rejection.

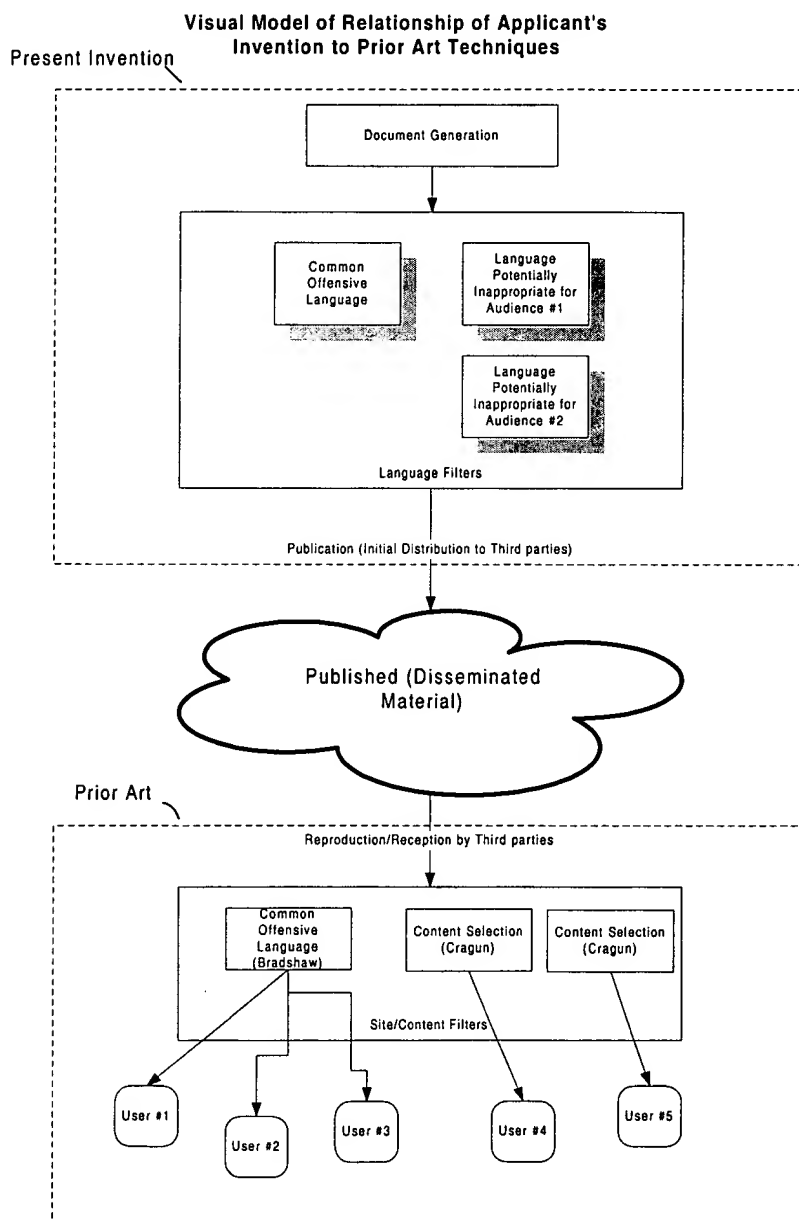
From a substantive perspective, again, the notion that the specification does not support a limitation of " $N > 2$ " or " $N \geq 2$ " (where for example  $N$  is a value of a filter status field for a word designing a level of inappropriateness) seems extremely specious, given that this particular feature is described at length in the specification, including in the areas already pointed out by the Applicants (see, e.g., pages 5, 8). If the Examiner is instead contending that one of skill in the art of electronic design would not know how to implement a status field (for an entry in an electronic table) to have more than 2 values, this, too, seems particularly indefensible.

In any event, Applicant submits that the rejection is again improper, but if such is going to be continued by the Examiner, the Applicants would appreciate at least some clarification to understand what the real contention is here.

## RESPONSE TO REJECTIONS UNDER § 103

### General discussion of the Prior Art

To help better illuminate the distinctions of the present invention over the prior art, Applicants submit the diagram below. This figure shows generally the difference in where and how the present invention operates, as opposed to the kinds of systems cited by the Examiner, as found for example in Bradshaw (US Patent No. 5,835,722) and Cragun I (US Patent No. 5,832,212) and Cragun II (US Patent No. 5,973,683).



Generally speaking, the present invention addresses problems and concerns associated with the top half of the creation/distribution/reproduction cycle of electronic materials, although some of the claims (discussed below) pertain to dual language filtering for documents that is applicable in a number of environments. A document, after it is generated, can be checked according to various filters/rules (i.e., for common offensive language and if desired one or more audience specific filters), *before* it is published/disseminated and made available to third parties. This avoids both intentional and/or inadvertent content problems in such document, at a time when corrective action can still be taken, and before it causes embarrassment and/or financial loss by virtue of the fact that it is now available for widespread reproduction/reception by other third parties.

Thus, the emphasis of a substantial number of the claims is on preventing the initial creation/distribution of materials to third parties, as opposed to preventing their reproduction after they are already otherwise in the hands of such third parties. Stated another way, these aspects of the present invention are not so concerned with *access* so much as with intelligent *distribution*, and so the Bradshaw filtering techniques (or Cragun content selection techniques) could be used in a complementary fashion with embodiments practicing the present claims.

Response to Paragraph 12 of the Office Action: rejection of claims 1, 6, 8, 11, 29 – 31, 40, 45, 47, 50, 66, 69, 76, 79 – 80, 82 and 83, 87 – 92, 109, 111, 114 – 115, 118 – 120, 122 and 123 in light of Bradshaw (U.S. Patent No. 5,835,722)

All of the above claims were rejected under § 103 in light of Bradshaw (U.S. Patent No. 5,835,722). As amended, however, the above claims present a number of different reasons that provide patentability. Some of these important distinctions include:

- 1) Bradshaw is directed to restricting access to already published materials, and not to controlling their initial creation/distribution;
- 2) Bradshaw has no teaching or suggestion for discriminating between different intended recipients of documents containing such words;

These points are addressed in detail below, and where appropriate for some of the claims, other points are presented as well.

Bradshaw is directed to restricting access to already published materials, and not to controlling their initial publication

As noted several times, the Bradshaw reference is primarily directed to the problem of blocking access by children and others to undesirable content *which is already publicly available* from different sources, such as vulgar and/or pornographic material on the internet. See, e.g. Bradshaw Abstract.

In contrast amended claim 1 is directed to controlling an electronic document which “has not been published” and the focus of this aspect of the invention is to ensure that:

“...the electronic document is checked so as to *control initial distribution* of such electronic document to said intended recipient.

Thus, this claim is directed to a different portion of the document creation – distribution – access cycle than Bradshaw, as noted in the above diagram. In particular, the present invention operates to prevent publication (i.e., distribution to an intended third party audience or to the public as a whole) of an electronic document, as opposed to its later access and reproduction by others. As there is simply no description or suggestion of any kind in Bradshaw or the other prior art for this type of operation, Applicant submits that this claim should be allowable.

Moreover, to the extent initial distribution is arguably controlled in Bradshaw (i.e., through keyboard entry interception) it is clearly not based on considering an “identity” of an intended recipient of any document created (if such actually occurs at all). The censoring, if such occurs, is based on a single rule created by a supervisor, and with no reference to either an author and/or a recipient.

Bradshaw has no teaching or suggestion for discriminating between different intended recipients of documents containing certain words

Even looking at the plain filtering capability in Bradshaw, there is no mechanism or teaching for the supervisor to discriminate between users, so that, for example, individuals (or groups of individuals) can be treated differently. The “filter words” in Bradshaw are fixed, and there is no attempt to create a “set” that is different, or that can be applied for different types of users in the same environment. In fact, the Examiner points out that Bradshaw mentions that the “user” may be a “child, student, or company employee...”; this amply demonstrates that the approach there is

indiscriminate, and that there is no effort or suggestion to tailor the filter according to the intended recipient. In other words, every user of the Bradshaw system is treated exactly the same, regardless of his/her identity, and this is 180 degrees opposite of what is emphasized in claim 1.

Again, the distinction arises because Bradshaw is concerned with accessing large databases of publicly available information at public libraries and the like, where one generic filter may be acceptable and/or beneficial for such purpose. Bradshaw is not concerned with developing word/recipient associations but rather a single rigid rule to exclude any possibility of a user viewing offensive material on the internet. In contrast, from the perspective of distributing a single document as described in this aspect of the invention, control of the filter depending on the intended recipient is a significant benefit.

Moreover, when a reference teaches away from the kind of modification proposed by the Examiner, a rejection for obviousness is not proper. See Fine, supra at 1599: “instead of suggesting that the system be used to detect nitrogen compounds, Eads deliberately seeks to avoid them; he warns against rather than teaches Fine’s invention.” Similarly, Gordon, supra at 112 reaches the same conclusion: “...if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose.....[I]n effect, French teaches away from the Board’s proposed modification.”

It is quite apparent that Bradshaw implicitly discourages one of skill in the art from modifying it in the fashion now proposed by the Examiner. This reality mitigates strongly against a suggestion that the combination of claim 1 is obvious.

As regards claim 1, therefore, Applicants submit that such as amended amply distinguishes over the teachings and any suggestions of Bradshaw, and should be in condition for allowance at this time.

Dependent claims 6, 8, and 11 should be allowable based on the fact that claim 1 patentably distinguishes over the prior art.

With regard to independent claim 29, Applicants submit that the Examiner did not apparently review Applicant’s amendments thereto, and has missed the crucial point that Bradshaw does *not* allow the author of a document to specify the “one or more word filter dictionaries” as set out in this claim. In fact, as noted by the Examiner, the supervisor in Bradshaw is the only person who can control the content of any filter, and this is quite different from the method of claim 29. Again, this subtle but important difference arises from the fact that as shown above, Bradshaw is

directed to a different problem and has little to say about helping a user control content of an electronic document.

Nonetheless this claim, too, has been amended as with claim 1 to make it apparent that the focus of this aspect of the invention is on controlling publication of a document, as opposed to restricting access of otherwise already publicly available documents.

Dependent claims 30 and 31 should be allowable based on the fact that claim 29 patentably distinguishes over the prior art.

Independent claim 40 has been similarly amended as with claims 1 and 29, and should therefore be allowable.

Dependent claims 45, 47 and 50 should be allowable based on the fact that claim 40 patentably distinguishes over the prior art.

Claims 66 and 69 actually depend from claim 61, and the latter has been rejected in light of two references so these former claims *cannot* be made obvious as a matter of law by Bradshaw alone as noted by the Examiner on page 8 of the Office Action. In any event the Applicants have endeavored to ascertain what the real rejection is for these claims, and the discussion for such is given below in connection with independent claim 61.

Independent claim 76 was originally rejected in light of Bradshaw, and Applicant amended it substantially in the last response. Nonetheless, the Examiner does not seem to have seen or considered the changes and discussions for such claim, as the same rejections as in the first Office Action were merely repeated in the Final Office action. These arguments are simply not applicable anymore, and Applicant requests either allowance of the claim or at least some clarification of the rejection, since it is not apparent what the Examiner is contending at this point. Again, from a substantive perspective, as noted in the prior Amendment, Bradshaw simply does not disclose or suggest the use of two different and separate types of language filters as set out in the claim. The Cragun et al references do not cure this deficiency, since they say nothing about checking documents *on a word by word* basis using a first and second language dictionary. This aspect of the invention permits content management and distribution to be much more intelligently controlled than the simple “one rule fits all” approach of Bradshaw and can be implemented in fact as a significant improvement in the same kinds of environments as Bradshaw and the prior art. Accordingly, allowance of this claim and its dependent claims (77 – 82) should also be proper at this time.



Dependent claim 83 depends from claim 1, and adds the further limitation that there are customized sets of filter words for different intended recipients. This claim should be allowable for the same reasons as for claim 1, and for the additional reason that Bradshaw has no means within his system for implementing different sets of filter words.

Dependent claim 86 also depends from claim 1, and adds the further limitation that the filter words are based on an ethnicity, gender and/or language speaking characteristic of an intended recipient. This claim should be allowable for the same reasons as for claim 1, and for the additional reason that while Bradshaw may catch "racial slurs," it provides no suggestion for tailoring this to particular user of the system.

Dependent claim 87 also depends from claim 1, and further specifies the kind of electronic document that is generated. Again, as noted earlier, as claim 1 should be allowable, this claim should be allowable as well for the same reasons. Furthermore and as discussed in detail above, Bradshaw is not really concerned with document creation/dissemination, but rather is directed to restricting access to materials that are already publicly available.

Dependent claims 88, 89 and 91 should be allowable for the same reasons as claim 86.

Dependent claims 90 and 92 should be allowable for the same reasons as claim 87.

Independent claim 109 has been amended in a manner similar to that as set forth above for claim 1, and for that reason should be allowable at this time as well.

Dependent claim 111 depends from claim 109, and further specifies that the software indicates which language filter has been triggered. This claim should be allowable for the same reasons as for claim 109, and for the additional reason that Bradshaw, while it may permit review of an e-mail log, does not provide any mechanism for the functionality of this claim; i.e., identifying which particular language filter detected an offensive and/or inappropriate word. Again, as Bradshaw does not even have multiple language filters for reviewing documents, it is not possible for it to disclose or suggest this concept in any event.

Dependent claim 114 depends from claim 109, and further specifies that the author of a document can control which language filters are used. Again, this claim should be allowable for the same reasons as for claim 109, and for the additional reason that as explained in the prior amendment, this type of functionality is expressly taught away from in Bradshaw, since the latter plainly discloses that the filters are set by a supervisor - not a user - and not for a particular document.

Independent claim 115 has been amended in a manner similar to that as set forth above for claim 1, and for that reason should be allowable at this time as well.

Independent claim 118 has similarly been amended in a manner similar to that as set forth above for claim 1, and for that reason should be allowable at this time as well. Moreover, there is simply no description or suggestion in Bradshaw of an implementation where two different kinds of filters are used in the same system based on two different groups of persons.

Dependent claims 119 – 120 depend from claim 118, and should be allowable for the same reasons.

Dependent claim 122 depends from claim 118, and should be allowable for the same reasons, and for the reasons set forth for claim 111.

Independent claim 123 has been amended in a manner similar to that as set forth above for claim 1, and for that reason should be allowable at this time as well. Again, to the extent that Bradshaw restricts initial document dissemination, it does not do so by considering an intended audience for such document – it simply blocks everything.

Response to paragraph 13 rejection of claims 2 - 5, 7, 13, 17 – 19, 21, 23, 27 – 28, 37 – 38, 41 – 42, 46, 52, 62 – 63, 65, 67 – 68, 72 – 74, 77 – 78, 81, 93 – 96, 97 – 100, 106 – 108, 110, 112 – 113, 116 – 117, 124, 127, 130, 137 and 140 in light of Bradshaw and Cragun I and Cragun II

The deficiencies of Bradshaw are not cured by anything found in Cragun I and/or Cragun II, as both of these references again indisputably deal with controlling access to already available or published information. There is no discussion or suggestion in either of these reference to achieve any measure of control over initial dissemination/distribution of an electronic document. Moreover, they teach and/or suggest nothing about multiple language filters checking electronic documents on a word by word basis.

Accordingly, dependent claims 2 – 5, 7 and 13 should be allowable for the same reasons as claim 1 above. Moreover, as regards claim 13, it should be noted that the “rating” referred to in Cragun II (which the Examiner contends an adult can control) is based on a television program, and does not operate on a *word* basis as set out in this claim.

Dependent claims 17 – 19, 21 and 23 actually depend from claim 14 and these former claims *cannot* be made obvious as a matter of law by such combination as the latter was *not* rejected in light of the above combination of references. In any event Applicants have made a substantial effort to

determine what the real applicable rejection is for these claims, and the discussion for the same is given below in connection with claim 14.

Dependent claims 27 – 28 actually depend from claim 24 and these former claims *cannot* be made obvious as a matter of law by such combination as the latter was *not* rejected in light of the above combination of references. In any event Applicants have made a substantial effort to determine what the real applicable rejection is for these claims, and the discussion for the same is given below in connection with claim 24.

Dependent claims 37 – 38 actually depend from claim 36 and these former claims *cannot* be made obvious as a matter of law by such combination as the latter was *not* rejected in light of the above combination of references. In any event Applicants have made a substantial effort to determine what the real applicable rejection is for these claims, and the discussion for the same is given below in connection with claim 36.

Dependent claims 41 – 42, 46 and 52 should be allowable for the same reasons as claim 40 above.

Independent claim 53 has been amended in a manner similar to that as set forth above for claim 1, and for that reason should be allowable at this time as well.

Dependent claims 62 – 63 and 71 actually depend from claim 61 and these former claims *cannot* be made obvious as a matter of law by such combination as the latter was *not* rejected in light of the above combination of references. In any event Applicants have made a substantial effort to determine what the real applicable rejection is for these claims, and the discussion for the same is given below in connection with claim 61.

Dependent claim 65 was already voluntarily canceled, so the rejection for this claim (page 14) is moot.

Independent claim 72 is believed to be already distinguishable over the art, including Bradshaw, by virtue of the fact that it specifically sets out two different electronic dictionaries for checking words. Again, as set out by the Examiner, this claim is contended to be non-patentable for the same reasons as claim 36 (see page 14), but the latter claim is not rejected in light of the above combination of references, so the present rejection is somewhat unclear. In any event, the Examiner apparently acknowledges that there is in fact *no* dictionary taught by Bradshaw (see page 22 discussion of claim 36) but then surprisingly proceeds from there to argue that no less than two very different types of dictionaries would be obvious from such reference. Applicants submit that

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this argument borders on improper speculation and hindsight reconstruction, since there is absolutely no mention or suggestion of the types of distinct dictionaries (one for general offensive language, and a separate one for language specific to a group of persons) as set out in the claim. Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As discussed in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination. Nonetheless, to make the distinctions absolutely clear, Applicants have amended the claim to emphasize such features, and submits that there is no reasonable basis for rejecting the claim in light of such reference.

Dependent claims 73 – 74 depending from claim 72 should be allowable for the same reasons as set forth above, and because they further specify that the “author of an electronic document” could modify the dictionaries (which is completely antithetical to the teachings of Bradshaw) and that there are a number of values for the status fields (which is again not taught by Bradshaw). Again, when a reference teaches away from the kind of modification proposed by the Examiner, a rejection for obviousness is not proper. See Fine, supra at 1599.

Dependent claims 77 – 78 and 81 depend from claim 76 and should be allowable for the same reasons as set forth for that claim above.

Independent claim 93 is similar to claim 13, but Applicants dispute that it stands or falls with such claim, since they are directed to slightly different aspects of the invention. Claim 13 is directed to a method of defining which words will be included within a particular filter (by specifying a threshold value) while claim 93 covers the use of a language sensitivity level threshold to evaluate an electronic document. Nevertheless, claim 93 is believed to be already distinguishable over the art, including Bradshaw and Cragun I and Cragun II in combination, by virtue of the fact that it specifically sets out a “language sensitivity threshold level” for examining words. Bradshaw mentions no ratings, and the other prior art merely refer to rankings set for Internet sites (Cragun I) and for television programs (Cragun II). Contrary to the Examiner’s contention, Applicant’s review of Cragun II reveals that it mentions nothing about checking content of an electronic document based on such a threshold, and thus it does not cure any deficiency in Bradshaw.

More importantly, all of these references again deal with restricting access to *already published* information, not to restricting initial dissemination of the same. In other words, these systems do

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not operate until it is too late (in many cases) to reverse the damage of an electronic communication containing offensive and/or harmful information, because the document is already published to the recipient or made available to the public as a whole. To make the distinctions absolutely clear, Applicants have amended the claim to emphasize such features, and submits that there is no reasonable basis for rejecting the claim at this point.

Dependent claims 94 – 96 depend from claim 93 and should be allowable for the same reasons as set forth for that claim above.

Independent claim 97 is similar to claim 93, and has been similarly amended to put it in condition for allowance. Its dependent claims 98 –100 should be allowable for the same reasons.

Independent claim 105 was rejected based on arguments for claims 3 and 12, but the latter claim was not rejected until much later in the Office Action for different reasons and based on different references (see page 25). Consequently, Applicant is not entirely sure what the real rejection is for this claim at this time, and so it is impossible to address it with any certainty. In any event, Applicant suspects that the Examiner has merely picked out portions of the claim, looked for such in no less than five very different references (Bradshaw, Cragun I, Cragun II, Newbold, Roth) and then combined them using the Applicant's disclosure as a blueprint. This is plainly hindsight reconstruction, and not an appropriate basis for an obviousness rejection. See In re Gorman, and Interconnect Planning Corp. v. Feil, supra; it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

Dependent claims 106 - 108 should be allowable for the same reasons as 105 already discussed above.

Dependent claims 110, 112 and 113 depend from claim 109, which has been discussed above; accordingly, they should be allowable at least for the same reasons. While they share some similarities to claims 23 and 6, 13 as noted by the Examiner, they do not stand or fall together, however, since they are derived from different dependent claims directed to different aspects of the present invention.

Dependent claims 116 - 117 depend from amended claim 115 and should be allowable for at least the same reasons.

Dependent claim 124 depends from amended claim 123 and should be allowable for at least the same reasons, and for the reasons set forth above explaining that the Applicants' dual language filters are not taught or suggested in the art.

Dependent claims 127, 130, 137 and 140 depend from claims 126, 129, 135 and 138 respectively, but the latter claims were not rejected until much later in the Office Action for different reasons and based on different references (see pages 24 - 25). Consequently, Applicant is not entirely sure what the real rejection is for these claims at this time, and so it is impossible to address it with any certainty. In any event, as with other rejections of this nature made in the Office Action, it appears that the Examiner has merely picked out portions of the claim, looked for such in no less than five very different references (Bradshaw, Cragun I, Cragun II, Newbold, Roth) and then combined them using the Applicant's disclosure as a blueprint. This is plainly hindsight reconstruction, and not an appropriate basis for an obviousness rejection.

Response to paragraph 14 rejection of claims 9 - 10, 14 - 16 (and 17 - 23), 32 - 33, 36 (and 37 - 39) 48 - 49, 61 (and 62 - 68 and 71), 75, 81, 84, 101 - 102, 125, 126 (and 127 - 128), 129 (and 130 - 131), 132 (and 133 - 134) 135 (and 136 - 137) 138 (and 139 - 140) in light of Bradshaw and Newbold

Dependent claims 9 - 10 depend from amended claim 1, and should be allowable for at least this reason.

Furthermore, as noted in the prior response, the Examiner's attempted combination of Bradshaw and Newbold - two very different types of systems - seems particularly suspect when one considers the teachings of these references as a whole. As is apparent from a reading of Bradshaw, the system is not designed or intended to be user-friendly (from the perspective of a document drafter), and this is nowhere more evident from the treatment it provides for people who accidentally put in inappropriate text (i.e., they are locked out from further access). Again, in the Bradshaw system, the system users are not permitted to change whether a word is contained within a "prohibited" list, because the point of that system is to completely block access to prohibited sites. Accordingly, Bradshaw in fact teaches away from the present invention, because it would defeat the purpose of the Bradshaw system if the users were permitted to define the words on such list. Thus, the Examiner's suggestion that one of skill in the art would combine Newbold with Bradshaw seems particularly inappropriate as a natural or logical addition to the latter's system.

Independent claim 14 was previously amended, and is submitted to be already allowable over the prior art of record. This claim is directed embodiments that assists an author of an electronic document to tailor his/her language content by providing them with a new tool so that word designations can be changed if necessary. The Examiner rejected claim 14 in the first Office *Amendment B & Response After Final for SN 09/014,414*

Action, but Applicants rebutted the arguments in detail in the first Amendment, and their submissions and arguments were not disputed by the Examiner in the most recent Office Action. As such, Applicants submit that maintaining the obviousness rejection is improper, since there has been little explanation by the Examiner to support the notion that one of skill in the art would be motivated to combine such references, and in fact the references on their face would lead one to an opposite conclusion.

Furthermore, as explained above, the Examiner apparently misunderstands the standard for determining obviousness of a claim, as is apparent from numerous sections of the Office Action, and thus claim 14 was improperly rejected the first time. This is amply evident from the following passage from the Office Action:

“...Bradshaw et al fail to teach ‘[b]’ determining whether said word has been spelled correctly...(citations omitted) Newbold et al disclose “...a spelling checker scans text to identify errors...” (citations omitted) It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Bradshaw et al, and Newbold et al, because Newbold et al teach “... A proof reading engine used to scan the text. Possible error types are: spelling, usage, custom usage.....” (citations omitted) such as the usage of an “potentially inappropriate” words as taught by the present invention. (Page 18 of the Office Action).

This contention is plainly insufficient to support an obviousness rejection, because it is far too conclusory. The Examiner acknowledges the deficiencies of Bradshaw, but then concludes *that the mere existence of a feature in Newbold* (spell checking) is in itself a suggestion to incorporate it into the former reference. There is in fact no evidence of a separate teaching, suggestion or motivation to include this feature in Bradshaw, however, and without the same an obviousness rejection is not sustainable.

Dependent claims 15 – 23 depending from claim 14 are allowable at least for the reasons set forth for claim 14. Claims 17, 18, 19, 21 and 23 were rejected in paragraph 13, but this appears to be in error because claim 14 (from which they depend) *was not* rejected in light of such references. To the extent Applicant understands the actual rejection, the Examiner is (apparently) combining selected portions of no less than five (5) different references to reject claims 17, 18, 19, 21 and 23 (see page 14 top paragraph). This fact alone demonstrates the tenuousness of the rejection, and the significant hindsight that has been employed. Applicants submit that this is insufficient to meet the burden required to demonstrate obviousness of the claims, and thus they should be allowed at this time.

Dependent claims 32 – 33 depend from amended claim 29, and should be allowable at least for the reasons set forth above for such claim.

Independent claim 36 has been amended, and should be allowable for similar reasons as set forth for claim 72 discussed above. This claim sets forth that the electronic dictionary is constructed so that two different types of words for two different types of audiences can be identified and detected. For example, the first dictionary may include commonly understood offensive words (i.e., words that most persons would consider inappropriate), while the second dictionary may contain potentially embarrassing or harmful content, or more specific ethnic, gender, age, or race sensitive words. Again, as mentioned above, the prior art does not distinguish between the two, and at most only considers common offensive words.

Dependent claim 39 depends from claim 36 and should be allowable for at least the same reasons as the latter claim.

Dependent claims 48 - 49 depend from claim 40 and should be allowable for at least the same reasons as such claim, and as explained above for claims 9 - 10.

Independent claim 61 was previously amended, and is believed to be allowable at this time for the reasons explained at length in the Amendment, and which the Examiner failed to respond to in any fashion. As set out in this claim, the user is not only alerted to the potential problem word, he/she is given an opportunity to change the word if necessary, and is further given a chance to specify rating values for words. This set of functionalities are not only not possible in Bradshaw, the disclosure therein expressly teaches away from giving users this degree of content distribution control.

Dependent claims 62, 63, 66, 69 and 71 were rejected in paragraph 13, but this appears to be in error because claim 61 (from which they depend) was not rejected in light of such references. To the extent Applicants understand the actual rejection, the Examiner is (apparently) combining selected portions of no less than five (5) different references to reject claims 62, 63, 66, 69 and 71 (see page 14 top paragraph). This fact alone demonstrates the tenuousness of the rejection, and the significant hindsight that has been employed. Applicants submit that this is insufficient to meet the burden required to demonstrate obviousness of the claims, and thus they should be allowed at this time

Dependent claims 67 – 68, depending from claim 61, are allowable for the same reasons, and for the reasons set forth in claims 9 – 10 above.



Dependent claim 75 depends from amended claim 72 and should be allowable for similar reasons as set forth for such claim discussed above.

Dependent claim 84 depends from amended claim 1 and should be allowable for similar reasons as set forth for such claim discussed above.

Independent claim 101 was (for reasons unknown to Applicants) rejected by the Examiner for reasons similar to those for claim 14 (see page 24). The Applicants dispute that these claims should be treated together, as they clearly recite different language and cover different types of embodiments. Again this claim is directed to a method of controlling distribution of an electronic document to prevent dissemination of embarrassing and/or harmful content. This claim is believed to be allowable, as it includes a step of identifying potentially inappropriate words that should not be included in an electronic document, which words are based in part on a consideration of an identity of the intended third party recipient. Again, even by the Examiner's reading of Bradshaw, it is apparent that such system does not consider an identity of any recipients of documents generated by the users of such system, so it cannot make obvious this claim.

Dependent claim 102 depending from claim 101 should be allowable for at least the same reasons. Moreover, Bradshaw mentions nothing of "replacing" words as part of a corrective action to put a document into better form for publication.

Dependent claim 125 depending from claim 123 should be allowable for at least the same reasons as such claim, and because the prior art does not disclose two different types of language filters.

Independent claim 126 was rejected by the Examiner based on reasons articulated for claims 36 and 111. Again, Applicants dispute that these claims should be treated together, as they clearly recite different language and cover different types of embodiments. Moreover, the Examiner has simply not addressed any of the arguments presented for this claim, including the fact that it sets out a system that checks content of a document based on two different language filters that are tailored based on two different groups of persons. This embodiment permits document distribution - document content control to be adjusted on a recipient by recipient basis - a concept that it is not even hinted at in the prior art.

Dependent claim 127 was improperly rejected in paragraph 13, but this appears to be in error because claim 126 (from which it depends) was not rejected in light of such references. To the extent Applicant understands the actual rejection, the Examiner is (apparently) combining selected

*Amendment B & Response After Final for SN 09/014,414*

portions of no less than five (5) different references to reject claim 127. This fact alone demonstrates the tenuousness of the rejection, and the significant hindsight that has been employed. Applicants submit that this is insufficient to meet the burden required to demonstrate obviousness of the claims, and thus the claim should be allowed at this time.

Dependent claim 128 depending from claim 126 should be allowable for at least the same reasons as such claim, and because the prior art does not disclose the *types* of language filters recited therein.

Independent claim 129 and its dependent claims 130 – 131 are allowable for similar reasons, and because in the prior art systems there is no notion or suggestion that language content for a document can be considered or specified differently between different documents. The arguments made by the Examiner refer to claims 14, but such discussion is inapplicable to the method described in claim 129, which focusses on a different aspect of the invention, namely, document distribution control on a document by document basis. Thus, the Examiner has not provided any meaningful rejection of the claim on the record.

Independent claim 132 and its dependent claims 133 – 134 are allowable for similar reasons to those set out above for claims 126 – 131. Furthermore, these aspects of the invention allow for controlled dissemination of electronic documents on a case by case basis by using a language filter that is based on the type of document being distributed. Again these claims have not really been addressed by the Examiner, and are believed to be clearly allowable over the art of record.

Independent claim 135 and its dependent claims 136 – 137 are allowable for similar reasons to those set out above for claims 126 – 134. Furthermore, these aspects of the invention allow for controlled dissemination of electronic documents on a case by case basis by using a language filter that is based on the type of document being distributed. Again these claims have not really been addressed by the Examiner, and are believed to be clearly allowable over the art of record.

Independent claim 138 and its dependent claims 139 – 140 are allowable for similar reasons to those set out above for claims 126 – 137.

Response to paragraph 15 rejection of claims 12, 23, 34, 51, 53 – 60 and 70 – 71 in light of Bradshaw taken in view of Newbold and Roth

Dependent claim 12 was indicated to be rejected in light of the above three references, but the body of the Office Action reveals that it is the case that these three references are actually combined with both Cragun et al – 1 and Cragun et al – 2 (see page 25). It is apparent from the discussion in this section of the Office Action that the Examiner is selectively picking and choosing elements from the references to arrive at the claimed combination, without any suggestion or teaching from such references to do such. This type of rejection, using hindsight and the present disclosure as a blueprint, is well-known to be inadequate for supporting a 103 rejection. Moreover, as a substantive matter, it is quite apparent that the prior art is not even talking about the same kind of method, wherein two different meanings for the same word are considered when evaluating a document. Accordingly, it is presented that this claim already amply distinguishes over the prior art, and for the reason that claim 1 (from which it depends) was also amended as noted above.

Dependent claim 23 depends from claim 14, and is allowable for the reasons set forth above, and for the reasons set out for claim 12.

Dependent claim 34 depends from claim 29, and is allowable for the reasons set forth above, and for the reasons set out for claim 12.

Dependent claims 43 – 44 depend from claim 40, and are allowable for the reasons set forth above for that claim, and for the reasons set out for claims 4, 5.

Dependent claim 51 depends from claim 40, and is allowable for the reasons set forth above, and for the reasons set out for claim 12.

Independent claim 53 is discussed above already; it has been amended in a manner similar to that as set forth above for claim 1, and for that reason should be allowable at this time as well.

Dependent claims 54 – 58 and 60, depending therefrom, should be allowable for the same reasons.

Dependent claim 70 depends from claim 61, and is allowable for the reasons set forth above, and for the reasons set out for claim 12.

Response to paragraph 16 rejection of claims 24 – 28 - in light of Mogilevsky (US Patent No. 5,649,222, Bradshaw and Roth

These claims were amended in the prior response, and were rejected again in the most recent Office Action under § 103 in light of the above references. Again, it appears to Applicants that the

Examiner has merely picked out the features of the claims in the references, and by their mere existence in one or more prior art references, argued that the combination is therefore obvious. For example, the primary reference relied upon, Bradshaw, fails to disclose no less than five (5) separate material limitations of claim 24 (see, e.g., pp. 30 – 32 of the Office Action). The Examiner then combines this reference with Mogilevsky, but fails to consider that on the whole, it is unlikely if not improbable that one skilled in the art would go against the plain teachings of Bradshaw (which is a filtering system) and impart a degree of user-friendliness (from the perspective of the document drafter) that is explicit in claim 24. Again, the Examiner has also failed to read the reference as a whole, and to note that Bradshaw “assists” the “word processing applications” by freezing out the user if he/she inputs an improper word. Thus, taken as a whole, it hardly suggests to one of skill in the art that the word processing user’s interactions should be improved in the manner called for in claims 24 – 28.

Furthermore, as noted in this claim, the user of a word processing program drafting documents can directly modify a word filter electronic dictionary containing the offensive and/or potentially inappropriate words, so that the user can control which words in the document are to be identified in the table. For example, a document drafter in the medical field may disable certain anatomical words from being automatically flagged. This type of editorial assistance is completely lacking in Bradshaw, and is inconsistent with the type of system shown there as well, which does not provide a word processing program user with any flexibility.

Accordingly, this claim, as previously amended, is submitted to distinguish over the type of approach shown in Bradshaw combined with Mogilevsky.

Claims 25 – 26 depend from claim 24, and are allowable for at least the same reasons as such claim.

Claims 27 – 28 were improperly rejected in paragraph 14 in light of Bradshaw and Cragun-I and Cragun-II; this plainly cannot be sustained since these claims depend from claim 24, and such claim was not rejected in light of such references. Nonetheless, as these claims depend from claim 24, they are allowable for at least the same reasons as such claim.

Response to paragraph 17 rejection of claims 103 - 104 - in light of Bradshaw taken with Newbold, Roth, and Cragun – I and Cragun – II

These claims depend from claim 101, and should be allowable for the same reasons.

Claims 35, 85 and 133

These claims were not actually rejected anywhere that Applicants can find in the bulk of the Office Action, but an effort nonetheless was made to try and discern the possible objection by the Examiner.

To the extent claim 35 is rejected, Applicants note that this claim depends from amended claim 29, and, for at least those reasons, should be in condition for allowance.

To the extent claim 133 is rejected, Applicants note that they depend from claim 132, and, at least for those reasons should be in condition for allowance.

Claim 85 was also rejected, but Applicants have amended claim 1 from which such claim depends, so this claim should be in condition for allowance. Moreover, Applicants note that the Examiner has not cited any reference in fact for the limitations therein, namely that "... a plurality of second electronic dictionaries in said one or more electronic dictionaries are checked to determine if said word is potentially inappropriate for a plurality of intended recipients, said plurality of second electronic dictionaries being individually customized to include words that may cause embarrassment or financial loss by their inclusion in the document to said plurality of recipients."

## CONCLUSION

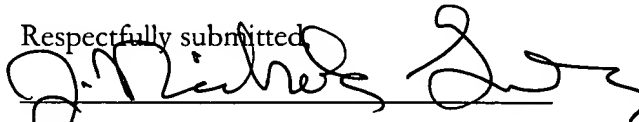
The objections and rejections of the Examiner have been considered in detail, and the claims have been amended to address such concerns. Accordingly, they are believed to be in patentable condition at this time.

This response is being filed within two months of the final Office Action.

Should the Examiner believe it that it would be helpful to discuss any of the above points in person, Applicant is open to a telephone conference (415-551-8298) at any convenient time.

Date: October 30, 2000

Respectfully submitted



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*I hereby certify that the foregoing is being deposited with the U.S. Postal Service, postage prepaid, to the Commissioner of Patents and Trademarks, this 30th<sup>th</sup> day of October 2000*